

Application Ser. No. 09/846,741

**REMARKS**

1. Applicant thanks the Examiner for his findings and conclusions.
2. It should be appreciated that Applicant has elected to amend Claims 12, 14, 17, 23, 27, and 28 solely for the purpose of expediting the patent process in a manner consistent with the PTO's Patent Business Goals, 65 Fed. Reg. 54603 (9/8/00). In making such amendments, Applicant has not and does not in any way narrow the scope of protection to which the Applicant considers the invention herein entitled. Rather, Applicant reserves Applicant's right to pursue such protection at a later point in time and merely seeks to pursue protection for the subject matter presented in this submission.

**Hilton Davis / Festo Statement**

The amendments herein were not made for any reason related to patentability. As for Claims 12 and 23, changes were implemented to clarify the invention. Claims 14, 17, 27, and 28 were amended to conform with standard claim drafting practices. None of the amendments are related to the pending rejections; these amendments were made for reasons other than patentability.

3. Claims 1, 2, 4-6, 9, 10, 12, 13, 15, 16, 18, 23, 26, 29, 34 and 35 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. patent no. 6,460,163 (hereinafter "Bowman").

**Claim 1**

As to Claim 1, respectfully the Applicant disagrees for at least two reasons.

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First, Claim 1 contains the required subject matter of  parsing said electronic correspondence to identify commercial correspondence. As the application as filed states at page 8, lines 8-11, there exist many kinds of electronic correspondence other than e-commerce, such as news, stock market alerts, and personal correspondence. The required subject matter of Claim 1 requires a step of parsing the received electronic correspondence to identify the commercial correspondence within the electronic correspondence. In stark contrast, Miller teaches receiving only digital receipts. A digital receipt is a commercial correspondence. Thus, Miller does not parse the incoming electronic correspondence to identify the commercial correspondence. To further support this argument, the cited sections of Bowman are analyzed. Bowman at Figure 4 describes receiving a digital receipt 401 as the first step and parsing the digital receipt 403 as the second step. Thus, Figure 4 of Bowman does not teach parsing incoming correspondence to identify commercial correspondence, but rather only teaches parsing a form of commercial correspondence. Further, Bowman at column 7, lines 18-19 states that block 401 receives digital receipts and at column 7, line 38 teaches that at block 403 the digital receipt is parsed. Block 403 is repeatedly described by Bowman at column 7, line 46 and at line 50 as parsing a digital receipt. Thus, at no point does Bowman describe the claimed subject matter of  parsing said electronic correspondence to identify commercial correspondence. Rather, Bowman only receives commercial correspondence. Accordingly, the rejection of Claim 1 and all claims dependent therefrom under 35 U.S.C. § 102(e) as being anticipated by Bowman is deemed to be improper.

Second, Claim 1 contains the required subject matter of  creating receipt data by extracting the commercial data. In stark contrast, Bowman at Figure 4 and at column 7, line 19 describes receiving a digital receipt. Bowman at column 7, lines 64-65 goes on to describe parsing the received digital receipt in order to validate the receipt. At no point does Bowman teach  creating receipt data by extracting the commercial data. Hence, Bowman does not teach all of the required subject matter of Claim 1. Accordingly, the rejection of Claim 1 and all

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claims dependent therefrom under 35 U.S.C. § 102(e) as being anticipated by Bowman is deemed to be improper.

### Claim 6

The Examiner states that Claim 6 contains limitations that are substantially equivalent to Claim 1 and is, therefore, rejected under the same basis. While the Applicant disagrees with Claim 6 being characterized as being characterized as being substantially equivalent to Claim 1, the Applicant does note that Claim 6 does require novel subject matter previously identified in Claim 1. Particularly, Claim 6 requires the step of parsing said electronic correspondence to identify commercial correspondence. As discussed, *supra*, Bowman does not parse incoming correspondence to identify commercial correspondence. Rather, the method of Bowman receives data known to be electronic receipts. Hence, Bowman does not teach all of the required subject matter of Claim 6. Accordingly, the rejection of Claim 6 and all claims dependent therefrom under 35 U.S.C. § 102(e) as being anticipated by Bowman is deemed to be improper.

### Claim 12

As to Claim 12, respectfully the Applicant disagrees for at least three reasons.

First, Claim 12 requires both the steps of parsing and extracting. The parsing step parses the electronic correspondence resulting in data content and the extracting step extracts the resulting data content in accordance with instructions. Bowman does not teach an extracting step following the parsing step. Bowman teaches at column 7, lines 64-67 that the digital receipt is either parsed to determine an expiration date or a retrieval step operating on a database entry is performed. The retrieval step is not equivalent to the extraction step as the extraction step operates on the parsed data and the retrieval step operates on an independent database entry. Hence, the required step of extracting the data

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content parsed from the electronic correspondence is not taught or suggested by Bowman. Accordingly, the rejection of Claim 12 and all claims dependent therefrom under 35 U.S.C. § 102(e) as being anticipated by Bowman is deemed to be improper.

Second, as described, *supra*, Claim 12 requires both the steps of parsing and extracting. Still further, Claim 12 requires that the extracting step is performed in accordance with instructions contained in the data records. As described, *supra*, the extracting step is not taught or described by Bowman. As the extracting step is not taught, the restriction on the extracting step as operating in accordance with instructions in the data records can not be taught by Bowman. Accordingly, the rejection of Claim 12 and all claims dependent therefrom under 35 U.S.C. § 102(e) as being anticipated by Bowman is deemed to be improper.

Third, the claimed invention requires incoming electronic commerce correspondence to the user. As described in the abstract of the application as filed, the application is directed at a method and system of automating capture of electronic data to provide a user with an effective universal internet identity and e-mail address, comprehensive e-mail filtering, and forwarding services. Further, in the application as filed at page 11, line 21 to page 12, line 4 the user is identified as accessing the internet through mobile devices, such as a PDA, from a boat, or over a television. In stark contrast, Bowman teaches in the first line of the abstract an e-commerce method for selling digital content over the internet. An e-commerce site is not a user. Even if an e-commerce site is viewed as a user of the internet, an e-commerce user is distinct from a user taught in the application as filed. Hence, the user requirement of Claim 12 is not the e-commerce site taught by Bowman. Therefore, the requirement of Claim 12 of a server receiving correspondence to the user is not taught by Bowman. Accordingly, the rejection of Claim 12 and all claims dependent therefrom under 35 U.S.C. § 102(e) as being anticipated by Bowman is deemed to be improper.

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As to Claim 12, to distinguish the claimed invention from the recited reference more thoroughly, Applicant amends Claim 12 to clarify that the instructions guiding the extracting step are user configurable preferences. Support for the amendment is found at least in the application as filed at page 8, lines 4-5; page 7, lines 12-13; and page 8, lines 8-9. As discussed, *supra*, Bowman does not describe the claimed extracting step. Further, Bowman does not describe use of user preferences. Therefore, Bowman can not have described extracting in accordance with user preferences. Accordingly, the rejection of Claim 12 and all claims dependent therefrom under 35 U.S.C. § 102(e) as being anticipated by Bowman is deemed to be overcome.

Claims 14 and 17 are amended to conform with standard claims drafting practices by providing proper descendent language.

### **Claim 23**

The Examiner states that "Claim 23 contains limitations substantially equivalent to claim 12 and is therefore rejected under the same basis."

In view of the above described differences between Bowman and Claim 12, the current rejection of Claim 23, under 35 U.S.C. § 102(e) as being anticipated by Bowman is deemed to be improper. Particularly, Claim 23 requires data extraction in accordance with instruction contained in the data records. As described, *supra*, the extraction requirement is not described in Bowman.

As to Claim 23, to distinguish the claimed invention from the recited reference more thoroughly, Applicant amends Claim 23 to clarify that the instruction are user configurable preferences. Support for the amendment is found at least in

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the application as filed at page 8, lines 4-5; page 7, lines 12-13; and page 8, lines 8-9. As discussed, *supra*, Bowman does not describe use of user configurable preferences. Accordingly, the rejection of Claim 23 and all claims dependent therefrom under 35 U.S.C. § 102(e) as being anticipated by Bowman is deemed to be overcome.

Claims 27 and 28 are amended to conform with standard claims drafting practices by providing proper descendent language.

4. Claims 3, 7, 8, 14, 17, 24, 25, and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bowman in view of U.S. patent no. 6,694,307 (hereinafter "Julien").

In view of the above described differences between Bowman and independent Claims 1, 6, 12, and 23, the current rejection of dependent Claims 3, 7, 8, 14, 17, 24, 25 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Bowman in view of Julien is rendered moot.

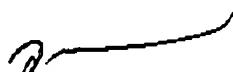
In view of the above described amendments to parent Claims 12 and 23, the current rejection of Claims 14, 17, 24, 25 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Bowman in view of Julien is rendered moot.

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CONCLUSIONS

In view of the above, this application is deemed to be in allowable condition. The Examiner is therefore earnestly requested to withdraw all outstanding rejections, allowing the application to pass to issue as a United States Patent. Should the Examiner have any questions regarding the application, he is respectfully urged to contact Applicant's attorney at (650) 474-8400.

Respectfully submitted,



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